Remarks

As stated above, Applicants appreciate the Examiner's thorough examination of the

subject application and request reexamination and reconsideration of the subject application in

view of the preceding amendments and the following remarks.

As of the office action of July 22, 2009, claims 1, 2, and 28-47 were pending in the

subject application, of which claims 1 and 37 are independent claims. With this response

applicant has amended claims 1 and 37.

A. Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 29, 37, and 40 under 35 U.S.C. § 103 over U.S. Patent

Application No. 2002/0169649 ("Lineberry") in view of U.S. Patent Application Publication No.

2002/0188452 ("Zhang"), U.S. Patent Application Publication No. 2002/0184191 ("Marpe"), and

U.S. Patent Application Publication No. 2002/0133444 ("Sankaran"). Office Action at p. 2.

Applicant contends that the combination of Lineberry, Zhang, Marpe, and Sankaran does not

result in the claimed invention because the combination does not disclose or suggest each and

every element of the amended claims.

Applicants have amended the independent claims to include, in part:

displaying, at the headcount analysis user interface, a graph of employee
redeployment related to one or more office locations of the at least two
enterprises, the graph of employee redeployment showing a number of open
positions, assigned positions, and unassigned positions;

displaying, at the headcount analysis user interface, a graph of employee
transition status for a particular office location, the graph of employee transition
status showing a number of unassigned positions, assigned positions, and open
positions for the particular office location

Appl. No.   10/750,229   Page 12 of 17
Amendment. Dated   October 21, 2009
Reply to Office action of   July 22, 2009
Attorney Docket No.   103580.00022/2003P00074US

These amendments find support throughout the subject application's specification and drawings.

See e.g. Subject Application at ¶ 95, FIGs 10-11. FIGs 10 and 11 provide examples of the

"graph of employee redeployment" and "graph of employee transition status" claimed:
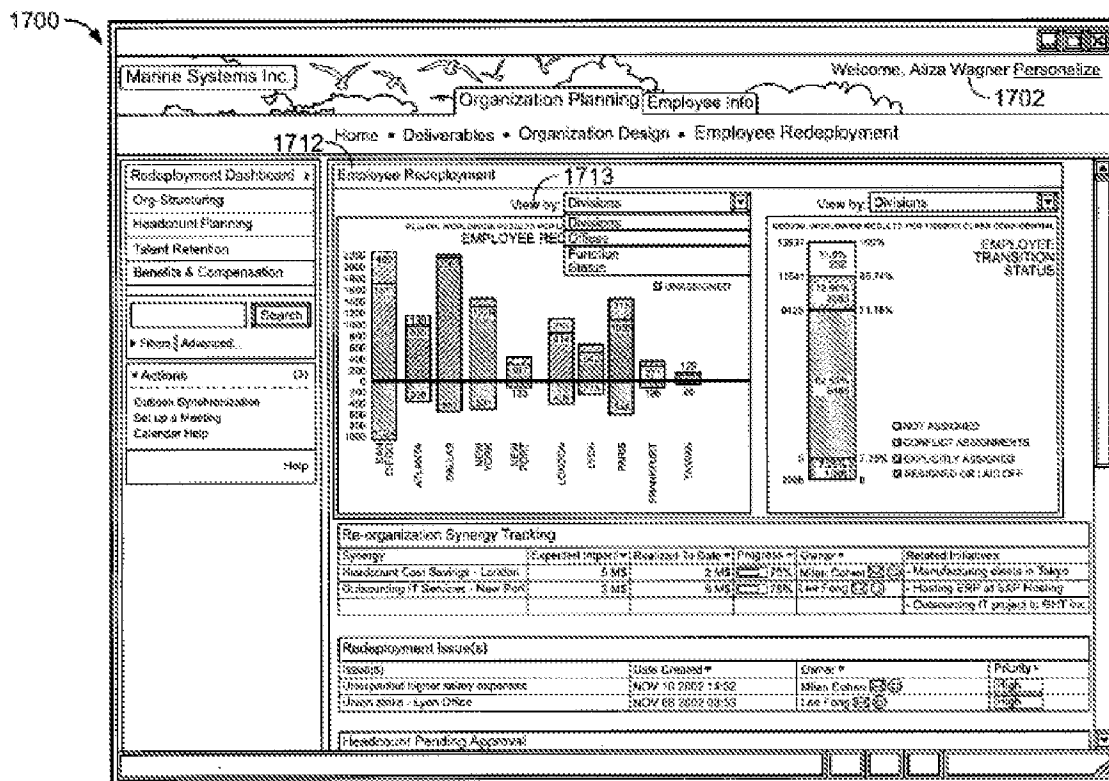

FIG. 10

As shown and described in the specification, the "graph of employee redeployment" and "graph

of employee transition status" relate to positions and headcounts in a merger. *Id.* The graphs

provide a user with the ability to manage redeployment throughout a merger process and view

headcount statistics for a particular office or across offices involved in the merger. *Id.*

      The combination of references does not appear to disclose displaying the "graph of

employee redeployment" and "graph of employee transition status," as claimed. As the

Examiner mentioned, Lineberry, Zhang, and Marpe do not appear to disclose or suggest certain

headcount functions, such as filtering or modifying headcounts. *See* Office Action at p. 7

("Lineberry/Zhang/Marpe combination does not expressly [dislcose]: . . . 'displaying . . . a

headcount . . . and modifying . . . current headcounts.") Similarly, the Lineberry/Zhang/Marpe

combination does not appear to disclose a "graph of employee redeployment" or a "graph of

employee transition status."

Nor does Sankaran appear to disclose displaying a "graph of employee redeployment"

and "graph of employee transition status," as claimed. Sankaran discloses a SpendCap manager

that categorizes spending. Sankaran at ¶ 41. One of Sankaran's spending categories appears to

be headcounts. *Id.* Sankaran also discloses a panel for generating reports, which may include

"named headcount" and "planned headcount additions." Id. at FIG. 16. However, Sankaran does

not describe these reports or the type of information they include. *Id.* at ¶ 86. Without a

description of the reports, it is unclear what information they compile.

Even so, Sankaran does not appear do disclose displaying a "graph of employee

redeployment" and "graph of employee transition status," as claimed. The claims recite:

> displaying, at the headcount analysis user interface, a graph of employee
> redeployment related to one or more office locations of the at least two
> enterprises, the graph of employee redeployment showing a number of open
> positions, assigned positions, and unassigned positions;

> displaying, at the headcount analysis user interface, a graph of employee
> transition status for a particular office location, the graph of employee transition
> status showing a number of unassigned positions, assigned positions, and open
> positions for the particular office location

Sankaran does not mention graphs related to headcounts in a merger, graphs related to one or

more office locations, graphs related to a particular office location, or graphs that contain open

positions, assigned positions, or unassigned positions.

Accordingly, since none of the combination of references appears to disclose displaying the "graph of employee redeployment" and "graph of employee transition status" as claimed in claims 1 and 37, Applicants contend that claims 1 and 37 are patentable under § 103. Applicants respectfully request withdrawal of the § 103 rejection of claims 1 and 37, as well as claims 2, 28-36, and 38-47 because they are ultimately dependent upon claims 1 or 37.

The Examiner, relying on *In re Gulack*, 703 F.3d 1381 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994), also asserts that "previous headcount transitions, predicted headcount transitions, and employee turnover rates" are nonfunctional descriptive data and do not distinguish the claimed invention from the prior art. Office Action at p. 10. Applicants respectfully disagree. Both *Gulack* and *Lowry* relate to printed matter rejections. However, both cases also describe limitations on when the USPTO can assert printed matter rejections.

The court in *Gulack* cautioned against liberally applying a printed subject matter rejection under § 103.

> A "printed matter rejection" under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art . . . .[The court], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated.

Gulack, 703 F.3d at 1385 (n. 8). Also, in *Lowry*, the court found that a specific type data structure could distinguish the claimed invention from the prior art, even though the data structure organized and referred to nonfunctional data. *Lowry*, 32 F.3d at 1583-85. A data structure stored in memory and having particular features was found to be distinguishable over the prior art since those features added functionality to the claims. *Id. Lowry*'s claims did not merely claim information in a memory structure, rather, they claimed data structures that depended on information in memory. *Id.* at 1583. The court found that Lowry's claims were

patentable under § 102 and § 103 because they sought to patent data structures that impose

organization on data, rather than merely seeking to patent the data itself. *Id.* The court

distinguished data structures from pure data and printed matter, which is not patentable under §§

102 and 103 because it is merely data. *Id.* at 1583-84. The court stated:

> Nor are the data structures analogous to printed matter. Lowry's [data structures]
> do not represent merely underlying data in a database. [The data structures]
> contain both information used by application programs and information regarding
> their physical interrelationships within a memory. Lowry's claims dictate how
> application programs manage information. Thus, Lowry's claims define
> functional characteristics of the memory.

Id.

Like *Lowry*'s claims, the present claims are not analogous to printed matter. The claims

at issue do not merely claim "details of at least one of said at least two enterprises, including

previous headcount transitions, predicted headcount transitions, and employee turnover rates."

Rather, claim 29 claims "*displaying, at the headcount analysis user interface,* details of at least

one of said at least two enterprises, including previous headcount transitions, predicted

headcount transitions, and employee turnover rates." Claim 40 includes a similar element. The

term "details [of] headcount transitions, predicted headcount transitions, and employee turnover

rates" acts within the claim to provide a particular function to the headcount analysis user

interface. Specifically, the term limits the headcount analysis user interface to one that displays

"details of . . . previous headcount transitions, predicted headcount transitions, and employee

turnover rates." This limitation is a functional limitation because it dictates how information is

displayed in the headcount analysis user interface.

Like the data structures in *Lowry*, the "details [of] headcount transitions" are used by the

claimed methods and systems, are part of the claimed methods and systems, and dictate how the

headcount analysis user interface displays data. *See e.g. Subject Application* at claim 29, 40.

The limitations are more than mere data without function. Therefore Applicants content that, like the limitations in *Lowry*, the limitation is functional.

The Examiner states that the specific types of details displayed are non-functional because "providing of a headcount interface would be performed the same regardless of what detail type is being displayed." Office Action at p. 10. This statement seems to suggest that *any* type of headcount interface is unpatentable over Lineberry as long as Lineberry merely discloses a headcount interface. But as discussed, the "details . . . including previous headcount transitions" act to limit the headcount interface to a particular type of headcount interface. This particular type of headcount interface is not disclosed by Lineberry (or the other cited references). *See Id.* ("Lineberry fails to expressly disclose '…details…including previous headcount transitions."). Accordingly, since the limitation provides functionality to the headcount interface, and since the references do not appear to disclose the limitation, Applicant requests withdrawal of the § 103 rejection of claims 29 and 40.

B. Conclusion

In consideration of the amendments and foregoing discussion, the application is now believed to be in condition for allowance. Early allowance of the subject application is respectfully solicited. The Examiner is kindly invited to contact Applicants' agent at 617-305-2136 to facilitate prosecution of the application.

This response should not require any additional fees. However, in the event that

additional fees are due, please charge or credit any refund to our Deposit Account No. 50-2324.

Respectfully Submitted,

Dated: October 21, 2009   /Seth A. Milman/
                                            Seth A. Milman
                                            Reg. No. 64,573

Holland & Knight LLP
10 St. James Avenue
Boston, MA 02116-3889
Telephone 617-305-2136
Facsimile 617-523-6850

8816987_v1